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Notice of Allowability	Application No.	Applicant(s)	
	10/805,885	BENBOW ET AL.	
	Examiner	Art Unit	
	Zachary C. Tucker	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 15th November 2006.
2. ☒ The allowed claim(s) is/are 1-5 and 15-18.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| <ol style="list-style-type: none"> 1. <input type="checkbox"/> Notice of References Cited (PTO-892) 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3. <input type="checkbox"/> Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____ 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | <ol style="list-style-type: none"> 5. <input type="checkbox"/> Notice of Informal Patent Application 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____ 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance 9. <input type="checkbox"/> Other _____ |
|---|---|

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

The examiner contacted applicants' counsel, Ye Hua, by telephone on 30th December 2006, to request permission to make the amendment, and left a telephone voicemail message to that effect. Later that afternoon, Ms. Hua returned the call, and left a voicemail message for the examiner authorizing him to make the changes.

IN THE CLAIMS –

Claim 5 has been amended thus:

5. A ~~pharmaceutically~~ pharmaceutical composition comprising the compound of claim 1, or a pharmaceutically acceptable salt thereof and a pharmaceutically acceptable carrier, vehicle or diluent.

Claim 18 has been amended thus:

18. A ~~pharmaceutically~~ pharmaceutical composition comprising the compound of claim 15, or a pharmaceutically acceptable salt thereof and a pharmaceutically acceptable carrier, vehicle or diluent.

end of amendments

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Request for Continued Examination

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's amendment and accompanying remarks, filed on 15th November 2006, has been entered and considered.

Response to Amendment

As requested in the correspondence from applicants filed 15th November 2006 (hereinafter "present amendment"), which is in reply to the Advisory Action mailed 26th September 2006 and the Final Rejection mailed 16 August 2006 (hereinafter "previous Office actions"), new claims 15-18 have been added.

Requirement for Restriction

In view of the present amendment, claims drawn to the elected invention, the compounds per se, are now in condition for allowance. Therefore claims 5 and 18, drawn to pharmaceutical compositions comprising compounds of the present invention, are rejoined.

The Requirement for Restriction as set out in the Office action mailed 23 February 2006 is hereby WITHDRAWN.

Status of Claim Rejections - 35 USC § 112

In the previous Office actions, claims 1-4 were finally rejected under the first paragraph of 35 U.S.C. 112, for failing to satisfy the written description requirement,

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specifically because the amendment to instant claim 1 filed originally 13th July 2006 was deemed to be new matter.

Upon reconsideration of the issue, review of applicants' argument traversing the rejection, and after consultation with other knowledgeable patent examiners, the examiner has arrived at the decision that the new matter rejection should be withdrawn.

Applicants specification exemplifies R¹ = chloro and R¹ = bromo species, the proviso as originally filed referred to fluoro- as the R¹ substituent, and the description of the invention holds hydrogen and isopropyl out to be functional equivalents of one another insofar as R^b is concerned, so the exemplified embodiments in the specification are sufficient to demonstrate that the species excluded by the proviso were in possession of the inventors at the time the invention was made. If applicants were in possession of the species excluded from the claims by the proviso as amended, then applicants have the right to exclude said species from the scope of the claims describing their invention.

Allowable Subject Matter

Claims 1-5 and 15-18 are allowed.

Closest prior art is the Sarges et al reference which was relied upon in the rejection under 35 U.S.C. 103 in the Non-Final Office action mailed 24th April 2006.

Sarges et al provides no teaching that would render compounds and compositions as presently claimed obvious to one of ordinary skill in the chemical and pharmaceutical arts.

Conclusion

All Post-Allowance Correspondence concerning this application must be mailed to:
Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450

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Alexandria, VA 22313-1450

Or you can fax them to the Office of Patent Publications at 703-872-9306, in order to expedite the handling of such correspondence as amendments under 37 CFR 1.312; information disclosure statements, and formal drawings. Sending Post-Allowance papers to Technology Center 1600 will only cause delays in matching papers with the case.

For information concerning status of correspondence sent after receipt of the Notice of Allowance, please contact the Correspondence Branch at (703) 305-8027. The Notice of Allowance also has an insert containing contact information on other items, including Issue Fees, receipt of formal drawings and the status of the application.



Zachary C. Tucker
Primary Examiner
Art Unit 1624